

ATTORNEY DOCKET NO.
014208.1304 (33-99-001)

09-15-04

PATENT APPLICATION
09/437,278

AF/3826

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: William J. Donovan, et al.
Serial No.: 09/437,278
Filing Date: November 10, 1999
Group No.: 3626
Examiner: Rachel L. Porter
Title: TRAVEL PRICING SYSTEM AND METHOD

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REPLY BRIEF

Pursuant to 37 C.F.R. § 1.193, Appellants respectfully file this Reply Brief, in triplicate, in response to the Examiner's Answer mailed July 14, 2004.

Appellants filed an Appeal Brief on April 2, 2004, explaining clearly and in detail why the final rejection of Claims 2-4, 7, 8, 10, 11, 14-20, and 24-30 was improper. First, the references upon which the Examiner relies (*Bohannon* and *Dettlebach*) do not disclose, teach, or suggest each and every limitation of Appellants' claims. Further, in making the proposed *Bohannon-Dettlebach* combination, the Examiner improperly reconstructs the invention in hindsight. As explained in more detail below, the Examiner's final rejection of the claims under appeal cannot be properly maintained. Appellants respectfully request that the Board reverse these final rejections and instruct the Examiner to issue a Notice of Allowance of Claims 2-4, 7, 8, 10, 11, 14-20, and 24-30.

A. The Examiner misstates Appellants' arguments and incorrectly asserts that the references of record disclose the features of the claims.

In rejecting Appellants' claims, the Examiner relies on *Bohannon* as the primary reference but acknowledges that *Bohannon* does not disclose that the records comprise travel attributes or that the second record format is different from the first record format. Rather, the Examiner relies on *Dettlebach* for disclosure of these features. In the Examiner's Answer, the Examiner suggests that Appellants have argued against the references individually and that this approach is improper. Specifically, the Examiner has stated that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Examiner's Answer, § 11(B), p. 22). However, Appellants respectfully deny having taken such an approach. To the contrary, it is Appellants position (and it has always been Appellants' position) that the combination of references fail to disclose each and every limitation in Appellants' claims. For example, in Appellants' Appeal Brief, Appellants demonstrated that neither *Bohannon* nor *Dettlebach* disclose, teach, or suggest "receiving . . . a second reservation record relating to the first type of record, . . . the travel attributes arranged in a second record format different from the first record format." (Appellants' Brief, page 9-11).

With regard to *Bohannon* specifically, Appellants have repeatedly demonstrated throughout prosecution of this patent application that at a minimum *Bohannon* does not disclose, teach, or suggest "receiving a second reservation record." (Appellants' Appeal

Brief, page 9-10). Rather, *Bohannon* merely discloses that an update transaction is received and that a copy of the existing record is internally created and stored. (Appeal Brief, page 9; *Bohannon*, Abstract, Figure 1, Column 48, line 58 through Column 5, line 19). Thus, it is Appellants' position (and it has always been Appellants' position) that neither the update transaction nor the copy of the existing record, as disclosed in *Bohannon*, are the equivalent of Applicants' claimed second reservation record. (Appeal Brief, page 9-10). As *Bohannon* does not disclose "receiving a second reservation record" at all, it is Appellants' position that *Bohannon* cannot be said to disclose "receiving . . . a second reservation record relating to the first type of record, . . . the travel attributes arranged in a second record format different from the first record format."

It has also been and continues to be Appellants' position that this identified deficiency of *Bohannon* is not cured by the disclosure of *Dettelbach*. In particular, and as stated in Appellants' Appeal Brief, *Dettelbach* also does not disclose, teach, or suggest "receiving . . . a second reservation record relating to the first type of record, . . . the travel attributes arranged in a second record format different from the first record format ." (Appeal Brief, pages 10-12). Specifically, Appellants have shown that *Dettelbach* specifies one format for each record type in direct contrast to receiving and storing two records of the same type in two different formats. (Appeal Brief, page 11). As such, Appellants have demonstrated that *Dettelbach* also does not disclose, teach, or suggest the recited features and operations and, in fact, teaches away from Appellants' claimed invention.

Accordingly, rather than attacking the references individually as suggested by the Examiner, Appellants have shown the recited features and operations to be completely absent from the disclosure of either reference of the proposed *Bohannon-Dettelbach* combination.

B. The Examiner improperly combines *Bohannon* with *Dettelbach* to reconstruct, in hindsight, Appellants' invention.

In their Appeal Brief (and throughout the prosecution of this case), Appellants explained why one of ordinary skill in the art would not be motivated to combine the references as proposed by the Examiner. (See Appellants' Brief, Pages 14-15). Appellants

acknowledge that the suggestion or motivation to combine may be found “either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” M.P.E.P. § 2143; *In re Fine*, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). However, although evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases from the nature of the problem solved, the range of sources available does not diminish the requirement for actual evidence. The Examiner has made no findings as to the level of ordinary skill in the art or the nature of the problems to be solved. Rather, Appellants submit that in rejecting the Appellants’ claims, the Examiner merely attempted to identify the elements of the claims in a combination of references and give a conclusory statement that it would be obvious to combine the references.

For example and with regard to Claim 24, the Examiner merely speculates that “it would have been obvious to one of ordinary skill in the art to modify the system of *Bohannon* with the teachings of *Dettelbach* to accommodate various types of data, including travel/reservations data.” (Final Office Action, Page 4). The Examiner further speculates that “[o]ne would have been motivated to include reservation data among the types of data accommodated by the *Bohannon* system to provide an efficient means to logically and economically age reservation data record versions in the main memory of a database, thereby allowing memory space to be reclaimed as it is needed.” (Final Office Action, Page 4). The portion of *Bohannon* relied upon by the Examiner, however, for providing the above recited suggestion merely acknowledges that a need exists to solve the problems associated with multi-versioning techniques. While the passage might invite one to read on within *Bohannon* to determine the solution specifically proposed by *Bohannon*, the passage would not have provided motivation or suggestion to one of ordinary skill in art at the time of the invention to combine the updating system of *Bohannon* with the record types of *Dettelbach* to arrive at Applicants’ claimed invention. Such a combination necessarily requires the use of impermissible hindsight reconstruction.

Moreover, the Federal Circuit has determined that this approach is improper and that broad conclusory statements such as the Examiner’s are not “evidence.” *In re Dembiczak*,

175 F.3d 994, 999 (Fed. Cir. 1999). Where the Examiner does not explain the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate one with no knowledge of applicant’s claimed invention to make the combination, the Federal Circuit infers that the Examiner selected the references with the assistance of hindsight. *Id.* The Examiner has stated that “any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning.” (Examiner’s Reply, § 11(A), Page 21). The Examiner has relied on *In re McLaughlin* for the proposition that “so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.” (Examiner’s Reply, § 11(A), Pages 21-22). Appellants submit, however, that the Examiner has not taken into account only knowledge within the level of ordinary skill in the art at the time the invention was made. Instead, the Examiner has used a reference-by-reference, limitation-by-limitation analysis to combine the references to meet the limitations of Appellants’ claims.

C. Appellants’ quotation of the Examiner for establishing the Examiner’s understanding of the teachings of *Dettelbach* are not improper.

The Examiner states that “Appellant has relied upon quotes from the First Office Action, the First Final Rejection, and the First Advisory Action for present application to support Appellant’s position regarding the *Dettelbach* reference.” (Examiner’s Reply, § 11(E), Page 26). The Examiner states that such “references to these previous Actions are moot, since the Appellant’s claim language has been amended, and the grounds of rejection provided to address the new limitations introduced by the Appellant have also changed.” (Examiner’s Reply, § 11(E), Page 26). Appellants respectfully submit, however, that Appellants’ references to these prior actions are not improper.

Appellants have merely quoted the Examiner’s various interpretations of *Dettelbach* as those interpretations have been set forth by the Examiner throughout the prosecution of this patent application. Although the combination of references, as relied upon by the Examiner, has changed, the content and disclosure of *Dettelbach* has not. Thus, the Examiner’s acknowledgement of what is and is not disclosed in *Dettelbach* is relevant to the

Examiner's understanding of the reference regardless of whether such statements occurred in the most recent final rejection of Appellants' claims or in a prior Office Action. Accordingly, Appellants respectfully submit that Appellants have not improperly quoted the Examiner in establishing the content and disclosure of *Dettelbach*.

For all the foregoing reasons, Appellants respectfully request that the Board reverse these final rejections and instruct the Examiner to issue a Notice of Allowance of Appellants' claims.

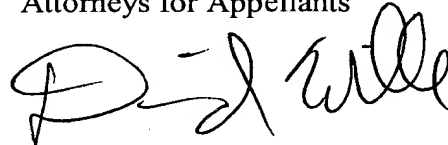
CONCLUSION

Appellants respectfully submit that the present invention as claimed is distinguishable over the cited art. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all pending claims.

Although Appellants believe no fees are due in connection with this Reply Brief, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants

A handwritten signature in black ink, appearing to read "D. G. Wille", is written over the printed name of David G. Wille.

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Dear Sir:

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that the attached Reply Brief (7 pages) filed in triplicate, a Baker Botts return postcard (1 postcard) and this Certificate of Mailing are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on this 14th day of September 2004, and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Willie Jiles

Willie Jiles

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